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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,172	07/03/2003	Geoffrey D.M. Wilkie	LKMP:112US	9139
7590 11/30/2004				
Edward Tracy, Jr., Esq. Simpson & Simpson, PLLC 5555 Main Street Williamsville, NY 14221-5406		EXAMINER VASUDEVA, AJAY		
		ART UNIT 3617 PAPER NUMBER		

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,172

Applicant(s)

WILKIE, GEOFFREY D.M.

Examiner

Ajay Vasudeva

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WV

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10, 12-17, 19-23 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 4, 11, 18 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The amendment filed 8/30/2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

On page 3:

extent. In some embodiments, membrane 40 is continuously attached to a hull (not shown) proximate to rim 250 and attached to pivot points 252 around opening 42. Then, as assembly 38 extends (Figure 6A), membrane 40 remains attached at points 252 and the portions of membrane 40 that were incident upon opening 42 flex/fold in an accordion-like fashion to take up the slack created by points 252 moving together. When assembly 38 retracts (Figure 6C), the membrane stretches between points 252. In an intermediate position (Figure 6B), membrane 40 may be partially stretched or may be partially flexed/folded.

On page 4, 5 and 6:

Vessel having passengers, payload or instrument (page 4)

Stabilizers moving relative to...the passengers, payload or instrument (page 5)

Passengers, payload or instrument may be carried within compartment (page 6)

On page 5 and 6:

Compartments includes a hatch and ports, both of which can be made fluid tight.

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

2. The amended drawings are objected to under 37 CFR 1.83(a) because they contain some new matter, as described previously in item #1 of this Office Action. Applicant is required to remove such new matter – newly added features and the numerals indicating such features -- and submit new drawings.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 8 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification, **as originally filed**, in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 8 and 22, the applicant claims a membrane operatively arranged to retract in diaphragm shutter like fashion. However, the disclosure, as originally filed, is silent on how such membrane would retract – whether in a diaphragm shutter like fashion, bellows/accordion fashion or by stretching. The disclosure, therefore, would not enable one skilled in the art to make and/or use the invention, as contemplated by the applicant.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 5-7, 9, 10, 12, 13, 15-17, 19-21, 23, 24, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Syfritt.

Syfritt shows (see figure 7) an apparatus for varying the dimensions of a vessel hull having a plurality of members [61] pivotally joined, and operatively arranged to extend and retract to vary the dimensions of the hull when the plurality of members are pivoted with respect to one another. The extension and retraction means are pneumatic or hydraulic means (see

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abstract). A plurality of plates [53, 59] are arranged to cover the pivotal members. A flexible membrane [54, 55] is connected to the hull with a watertight seal (figure 10).

Regarding claims 13 and 27, the limitation "submersible vessel" has been interpreted to mean such vessel that can, at least partially, be under a water surface. In the present case, the hull of Syfritt is considered submersible.

7. Claims 1, 5, 7, 14, 15, 19, 21, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor.

Taylor shows an apparatus (figure 4) for varying the dimensions of an airship hull having a plurality of members [9, 10, 11] pivotally joined, and operatively arranged to extend and retract to vary the dimensions of the hull when the plurality of members are pivoted with respect to one another. A flexible membrane is connected to the hull with a seal (figures 7 and 8).

Allowable Subject Matter

8. Claims 4, 11, 18 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 8 and 22 would be allowable if:

- the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action are overcome, and .

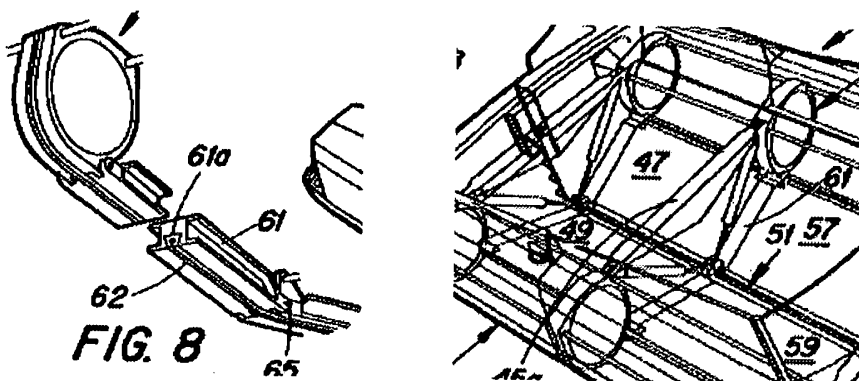
- the claims are rewritten to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed 8/30/2004 have been fully considered but they are not persuasive.

102(e) rejection based on Syfritt: The applicant has referred to figures 11a-11c, and argued that Syfritt does not show a truss assembly.

Examiners Answer: The Examiner has applied the embodiment shown in figures 7-10, and not figures 11a-11c. The arrangement of tie members 61 is considered equivalent to a truss assembly (see col. 9, lines 34-35; and the figures below).

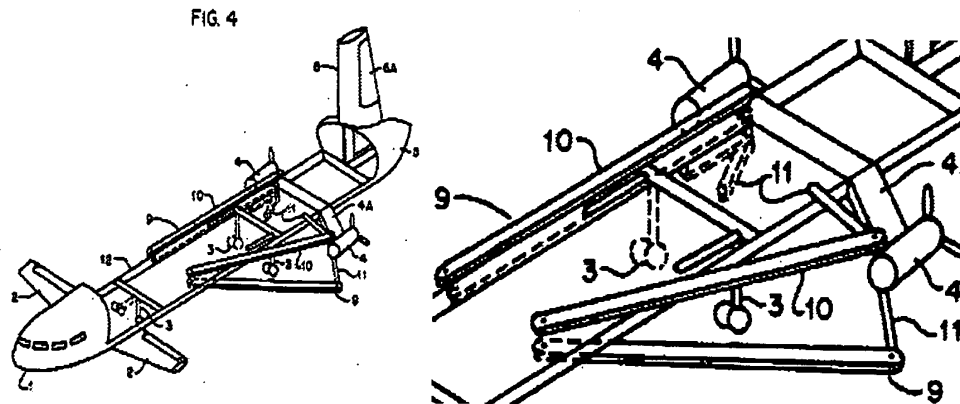


102(b) rejection based on Taylor: The applicant has argued that a truss is defined as "a frame...built from members in tension and compression", and that Taylor shows only pivoting and folding arrangement of spars, but these spars are not in tension or compression. Therefore, Taylor does not teach a truss assembly.

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Examiners Answer: A truss is simply any framework, designed to provide support.

Further, the spars of Taylor are capable of withstanding both "tension and/or compression" stresses, even if they are not subjected to such forces. Applicant may further note the following excerpts from Taylor:



In col. 4, line 21-29:

loped shape. The wings can be extended in a number of ways. First, a mechanical pair of wing spars can be extended. These wing spars include a pair mechanical wing frame sections which are pivotally connected to the rigid airship frame, and which are enclosed in the flexible wing expansion sections. For wing deployment, the wing spars are pivoted into a position such that the wings are extended, and so the flexible wing expansion sections become inflated wings.

Conclusion

11. The prior art made of record in the attached PTO Form 892, but not yet relied upon, is considered pertinent to applicant's disclosure:

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (703) 306-5992. The examiner can normally be reached on Monday-Friday 1:00 pm--5:30 pm.

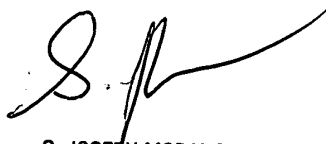
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


AV

Ajay Vasudeva
Examiner
Art Unit 3617


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